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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,169	09/18/2003	Alan K. Snell	1032.005	6319

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EXAMINER	
KIDWELL, MICHELE M	
ART UNIT	**PAPER NUMBER**
3761	

MAIL DATE	DELIVERY MODE
06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/665,169	SNELL, ALAN K.	
	Examiner	Art Unit	
	Michele Kidwell	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2006 and 09 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *50-52,62,73,74,78,80,81,86 and 87* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *50-52,62,73,74,78,80,81,86 and 87* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/7/06;5/21/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50, 52 and 62 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Narawa (JP 10-95481).

In regard to Claims 50 and 62, Narawa et al. disclose an unused diaper 2 that is hermetically sealed (i.e., has an airtight seal) within an air impermeable encasement 3 after being vacuumed) (analogous to air being removed from the encasement (abstract, means for solving the problem, effect of the invention, examples). Because Narawa et al. disclose removing air from the encasement, and then closing the encasement with an airtight seal, this inherently created a partial vacuum. The diaper is compressed ([0010]). Because Narawa disclose reducing the thickness of the diaper, the volume is inherently reduced [0015]. Narawa et al. further disclose that the encasement 3 encloses only one diaper and has a substantially rectangular shape (Drawings 1, 4, 8-10; title; abstract, [0014]). Narawa et al. further disclose that the diaper 2 is folded at least twice in a lengthwise direction (Drawings; [0027]-[0029], Examiner's markups-attached). One configuration comprises folds in both the length and width direction that may be considered as half of the "nominal" configuration (Fig. 7-8). A length of the diaper (in this case the "width") can be "foldedly reduced" to one-third or one-fourth of

the "nominal configuration" (Fig. 6). Likewise, the claim recites that the fold reduces a width of the diaper by at least ½. A width may be considered as any portion of the diaper needed to meet the claimed limitation. Also see discussion for Claim 42.

In regard to Claim 52, the encasement 3 comprises a notch 36 to facilitate opening of the encasement 3 (Drawing 1; Embodiment of the Invention- [0020]-[0021]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 51, 73 – 74, 78, 80 – 81 and 86 – 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narawa et al.

In regard to Claims 51, 73, 74, 78, 80 and 86, Narawa et al. disclose the claimed invention, as discussed previously, see especially discussion regarding claim 50, but do not expressly disclose that the package has specific dimensions. However, Narawa et al. do disclose compressing a diaper so as to reduce its thickness and to be compact (i.e. pocketable) for carrying convenience. The ability to carry/transport the package within various desired locations depends on the dimensions of the package itself; thus, the package dimensions are considered to be a result effective variable. Thus, it would have been obvious to one of ordinary skill in the art to provide the package with specific dimensions, since it has been held that discovering an optimum value of a result

effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

In regard to Claims 81 and 87, see previous discussion for Claims 52 and 62-64.

Response to Arguments

Applicant's arguments filed December 7, 2006 have been fully considered but they are not persuasive.

Initially, the examiner notes that the applicant's arguments are not commensurate with the scope of the claims. The applicant argues that Narawa does not disclose a folding of a diaper to reduce the width of the diaper in comparison to the width of a diaper in a nominal configuration. However, the claim only requires a reduction in a width, not necessarily the total width and not the width in comparison to the width of a diaper in a nominal configuration. As noted in the rejection, a width may be considered as any portion of the diaper needed to meet the claimed limitation. Regarding the applicant's arguments pertaining to the sum of two of the three dimensions, the examiner maintains that the ability to carry/transport the package within various desired locations depends on the dimensions of the package itself; thus, the package dimensions are considered to be a result effective variable. Thus, it would have been obvious to one of ordinary skill in the art to provide the package with specific dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).*

Applicant has further argued that Claims 80 and 86 recite a novel feature of the invention, which was not previously recognized: that the final thickness of the compressed (vacuum-packed) diaper is approximately the same thickness of the nominally-configured diaper. However, the optimization of a range has no patentable significance unless a new and unexpected result is produced. In this case, it would have been obvious to one of ordinary skill in the art that optimizing the dimensions of the compressed diaper would allow for a reduced configuration to fit within a variety of desired spaces and locations.

Likewise, it is noted that the features upon which applicant relies (i.e., specific dimensions with respect to a nominal configuration) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.
See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michele Kidwell
Primary Examiner
Art Unit 3761